UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,894	08/25/2000	Peter L. Katsikas	PKAY-P1	6988

		EXAMINER
7590　　12/24/2003		HOFFMAN, BRANDON S

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ART UNIT	PAPER NUMBER
2136	

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- Th MAILING DATE of this communication appears on the cover she t with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>25 August 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
   since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
   37 CFR 1.78.

   a)☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
   reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,4,6,7</u>.

4)☐ Interview Summary (PTO-413) Paper No(s). _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

Specification

1.   The disclosure is objected to because of the following informalities: on page 14,

line 12, "thrid" should be –third–.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3.   Claim 1-3, 8-13, 16-20 are rejected under 35 U.S.C. 102(a) as being anticipated

by Hashimoto et al. (U.S. Patent No. 5,931,905).

Regarding claims 1, 13, and 18, Hashimoto et al. teaches a method/email server

system for eliminating unauthorized email sent to a user on a network comprising:

- An email client for allowing the user to receive email sent on the network

  addressed to a unique email address of the user (fig. 1, ref. num 10),

- An email-receiving server connected between the network and the email client

  for receiving email addressed to the unique email address of the user (fig. 1, ref.

  num 30),

    o Said email-receiving server having an authorized senders list (ASL)

module which maintains an ASL list of email addresses of senders

authorized to send email to the user (col. 12, lines 38-41), and

- An email rejection module operable with the ASL module for rejecting the receipt

of email addressed to the email address of the user if the email address of the

sender is not one that is maintained on the ASL list by returning an error

message to the sender (col. 12, line 62 through col. 13, line 4).

Regarding claims 2 and 19, Hashimoto et al. teaches wherein the ASL module

includes:

- An ASL database for storing ASL lists of authorized sender addresses for

respective subscribers of the system (col. 12, lines 37-41),

- A spam processor module for checking the ASL lists for matches (col. 12, line 67

through col. 13, line 4), and

- An ASL manager for creating, maintaining, and updating the ASL lists (col. 12,

lines 43-48).

Regarding claims 3 and 20, Hashimoto et al. teaches further comprising a

redirector module operable with the ASL module:

- For receiving an email-sending message designating the sender's FROM

address and intended recipient's TO address (fig. 7, "SENDER" and

"DESTINATION"),

- For sending a request for validation to the spam processor module to determine whether the sender's FROM address matches any authorized sender address maintained on the ASL list corresponding to the TO address of the intended recipient (col. 12, lines 62-67),

- For accepting the email if a match to an authorized sender address is found (col. 12, line 67 through col. 13, line 1), and

- For rejecting the email if no match to an authorized sender address is found on the ASL list (col. 13, lines 2-4).

Regarding claim 8, Hashimoto et al. teaches further comprising an email-receiving manager for capturing FROM and TO addresses of email accepted by the redirector-module and sending the data to the ASL manager for later analysis (fig. 17, ref. num 25 of receiving end).

Regarding claim 9, Hashimoto et al. teaches further comprising an email-sending manager for capturing FROM and TO addresses of email sent from the email client and sending the data to the ASL manager for later analysis (fig. 17, ref. num 25 of sending end).

Regarding claims 10 and 16, Hashimoto et al. teaches wherein the ASL manager further includes a rules processor for processing predefined address capture rules for updating the ASL lists using data from an email address source selected from the group

of email address sources consisting of: received email; sent email; user inputs to email

service functions on the email client; inputs from user browsing of web sites; user

desktop organizer and other contact lists; and third party address program inputs (fig.

57, ref. num 41).

Regarding claims 11 and 17, Hashimoto et al. teaches wherein the ASL manager

further comprises a rules processor for processing predefined analysis rules for

updating the ASL lists using data from an analysis source selected from the group of

analysis sources consisting of: user email log analysis; expiration date analysis;

low/high email volume analysis; fuzzy logic analysis; and third party data analysis.

Applicant states, on page 4, first paragraph, of the preliminary amendment

received on August 23, 2001, "all email systems, like the Hashimoto system only scans

the FROM and TO addresses of the subscriber's email in order to maintain a log

identifying the email the subscribers has sent and received." This admission suggests

that the Hashimoto et al. patent, as well as other patents and publications, discloses the

ASL manager selects from the group of analysis sources consisting of user email log

analysis. This clearly labels the above claims as unpatentable based over a prior art

teaching.

Regarding claim 12, Hashimoto et al. teaches wherein the ASL manager

maintains the ASL lists designating a sender-address status selected from the group of

sender-address statuses consisting of: always authorized as a friend; authorized as a

friend over a date range; authorized as a friend before an expiration date; always

rejected as a spammer; rejected as a spammer matching a black list; and rejected as a

spammer sent with an error message (col. 13, lines 5-24).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 4-7, 14, and 15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hashimoto et al. (U.S. Patent No. 5,931,905) in view of Lillibridge et

al. (U.S. Patent No. 6,195,698).

        Regarding claims 4 and 14, Hashimoto et al. teaches replying to the sender of a

rejected email, a message indicating the rejection (col. 13, lines 2-4). However,

Hashimoto et al. does not disclose further comprising a web-based messaging (WBM)

module to confirm that the sender is a legitimate sender of email to the intended

recipient.

Lillibridge et al. teaches further comprising a web-based messaging (WBM)

module to confirm that the sender is a legitimate sender of email to the intended

recipient (fig. 5).

It would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to combine a WBM module to confirm that a sender is a legitimate

sender of email to the intended recipient, as taught by Lillibridge et al., to the

method/system of Hashimoto et al. It would have been obvious to one of ordinary skill

in the art to combine a WBM module to confirm that a sender is a legitimate sender of

email to the intended recipient, as taught by Lillibridge et al. to the method/system of

Hashimoto et al. because most SPAM messages are generated by a machine/agent to

distribute to thousands of email addresses. The WBM module will prevent non-human

messages from getting to a receivers inbox, thus reducing the hassle of SPAM (see col.

9, lines 3-8 of Lillibridge et al.).

This new method/system, as taught by the combination of Hashimoto et al. and

Lillibridge et al. would cause a unregistered email account to be authenticated by the

WBM module. This module would force a sender to type in humanly perceptible

characters to verify the sender is indeed a human. After correctly typing in the

characters, the sender would be allowed to send a message to the intended recipient.

Regarding claims 5 and 15, the combination of Hashimoto et al./Lillibridge et al.

teaches wherein the WBM module includes a separate web site (see col. 5, lines 41-43

of Lillibridge et al.) to which the notified sender can log on and confirm that the sender is a legitimate sender of email through an interaction procedure which can only be performed by a human (see col. 6, lines 11-16 of Lillibridge et al.).

Regarding claim 6, the combination of Hashimoto et al./Lillibridge et al. teaches wherein the interaction procedure includes a display of a graphic image of a word in a non-standard font (see fig. 4, ref. num 410 of Lillibridge et al.), and an input for the sender to enter in a word corresponding to the graphic image of the word (see fig. 4, ref. num 420 of Lillibridge et al.), whereby the system can confirm that the interaction procedure is not performed by a mechanical program (see col. 5, lines 65-67 of Lillibridge et al.).

Regarding claim 7, the combination of Hashimoto et al./Lillibridge et al. teaches wherein once the sender is confirmed as a legitimate sender of email to the intended recipient user, the WBM module sends the email to the user's email box with a code that indicates that the email was rejected by the redirector module but confirmed as legitimate by the WBM module (see col. 6, lines 64-67 of Lillibridge et al., in this case, the request, Q, is to send a message to the recipient.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Hoffman whose telephone number is 703-305-4662. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for

the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-305-

3900.

Brenda Hofl

BH
12/19/03

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